

Application No.: 10/727,518

Docket No.: 21581-00260-US1

REMARKS

Claims 9 and 12-21 are now in the application. Claims 9 and 12-14 are directed to the elected invention. Claims 15-21 are directed to a non-elected invention. The examiner is granted authority to cancel claims 15-21 upon the allowance of the claims directed to the elected invention.

Claim 9 has been amended to include recitations from claim 11 reciting "a perchlorate of a divalent or trivalent metal". Accordingly, claim 11 has been canceled without prejudice.

Claims 9 and 11-13 were rejected under 35 U.S.C. 103(a) as being obvious over EP 043,963. EP 043,963 fails to render obvious claims 9 and 12-13.

As mentioned above, claim 9 recites "perchlorate of a divalent or trivalent metal" when referring to the catalyst. Contrary to this, '963 suggests that the acid catalyst used in the first stage of the process can be one of the well known class of the catalysts such as the fluorides and chlorides of boron, aluminum, iron, tin, titanium and complexes of such halides with ethyl ether, and that sulfuric acid and phosphoric acid also are effective. It is asserted in the Office Action that the teaching of sulfuric acid of phosphoric acid by '963 would suggest salts of these acids since one skilled in the art would have a reasonable expectation of success to use the salts of the acids in the process taught by '963. However, '963 does not teach perchloric acid as an acid catalyst and it is not obvious for persons skilled in the art to use salts of perchloric acid for such purpose. EP 043,963 fails to disclose the catalyst (d) as now recited in amended Claim 9.

Furthermore, it is stated in the Office Action that the alkylene oxide adduct as taught by '963 would inherently have the same distribution constant as recited by the instant claims. However, '963 does not disclose the molecular weight distribution of alkylene oxide adduct. The alkylene oxide adduct of the present invention has great emulsification and detergency because of its narrow molecular weight distribution thereof. On the contrary, '963 neither discloses nor suggests emulsification and detergency. Accordingly, persons skilled in the art would not expect that an alkylene oxide adduct having the narrow molecular weight distribution is obtained by the reaction of alkylene oxide and alcohol in the presence of the catalyst (d) recited in amended Claim 9 and the obtained alkylene oxide adduct would have great emulsification and detergency. Therefore, the amended Claim 9 and its dependent Claims 12-13 are nonobvious over EP 043963

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Claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over EP 043,963 in view of U.S. Patent 3,281,399 to Renaudo et al. (hereinafter "Renaudo"). Renaudo does not overcome the above discussed deficiencies of EP 043,963 with respect to rendering unpatentable claims 9 and 11-13. Renaudo was merely relied upon for a disclosure of removal of catalyst residues from polymers. Accordingly, claim 14 is patentable for those reasons as to why claim 9 is patentable.

The mere fact that cited art may be modified in the manner suggested in the Office Action does not make this modification obvious, unless the cited art suggest the desirability of the modification. No such suggestion appears in the cited art in this matter. The Examiner's attention is kindly directed to *In re Lee* 61 USPQ2d 1430 (Fed. Cir. 2002) *In re Dembiczak et al.* 50 USPQ2d. 1614 (Fed. Cir. 1999), *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984), *In re Laskowski*, 10 USPQ2d. 1397 (Fed. Cir. 1989) and *In re Fritch*, 23, USPQ2d. 1780 (Fed. Cir. 1992).

In *Dembiczak et al.*, supra, the Court at 1617 stated: "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc., v. M3 Sys., Inc., 157 F.3d. 1340, 1352, 48 USPQ2d. 1225, 1232 (Fed. Cir. 1998) (describing 'teaching or suggestion motivation [to combine]' as in 'essential evidentiary component of an obviousness holding'), In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d. 1453, 1459 (Fed. Cir. 1998) ('the Board must identify specifically...the reasons one of ordinary skill in the art would have been motivated to select the references and combine them');...".

In view of the above, consideration and allowance are, therefore, respectfully solicited.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.


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The Director is hereby authorized to charge any fees, or credit any overpayment, associated with this communication, including any extension fees, to Deposit Account No. 22-0185.

Dated:

Respectfully submitted,

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